

REMARKS

In the outstanding Office Action Claims 13, 64-73, 75-82 and 85 were rejected under 35 USC §112, first paragraph, as being based on a disclosure which is not enabling. In particular, the Examiner noted *In re Mayhew*, 188 USPQ 356 (CCPA 1976) and stated that inasmuch as the use of hydrogen peroxide appeared to be an essential feature not appearing in the claims, the claims were not enabled.

Claims 13, 64-73, 75-82 and 85 were also rejected under 35 USC §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Specifically, the terminology "elevated temperature and pressure" was objected to as being a relative term.

All previous rejections in this case were withdrawn.

As amended, this case is believed in condition for allowance in view of the following remarks.

New Claims 86-89 have been added claiming specific treatment temperatures and pressures. Support for new Claims 86-89 is seen in the application as filed, p. 15, lines 1-15.

With regard to the Examiner's contention that hydrogen peroxide is an essential unclaimed feature, the specification of this case teaches to the contrary. Criticality of the bleaching agent is not part of the claimed subject matter in this case and hydrogen peroxide bleaching is merely a preferred embodiment of the invention. In this regard, the Examiner's attention is directed to p. 15, lines 17-18 of the specification as filed:

In a particularly preferred aspect of the invention, the fiber is heat treated and curled in the presence of an alkaline agent and a peroxide bleach.

Note also, p. 16, line 12 where sodium peroxide and potassium peroxide are listed as suitable bleaching agents, as well as p. 17, lines 1-7 where various peroxyacids are listed as suitable bleaching agents.

In view of the disclosure, the §112, first paragraph rejection under *Mayhew* should be withdrawn. While it is undisputed that where an essential feature is not recited in the claims an enablement rejection should be made, it is equally clear that preferred features need not appear in a claim. MPEP §2164.08(c). *So also*, in determining whether an unclaimed feature is critical, the entire disclosure must be considered. In *Mayhew*, the disclosure clearly taught that a cooling bath was critical to achieving the claimed process. That is not the case in the present application where the use of hydrogen peroxide is merely a preferred embodiment, much as in the circumstances considered in *In re Goffe*, 191 USPQ 429 (CCPA 1976).

In *Goffe*, the Court reversed the §112, first paragraph enablement rejections noting that:

[W]e cannot agree with the board's determination that the claims are inclusive of materials which would not apparently be operative in the claimed process. *** Having stated the objective *** together with the process steps, use of materials which might prevent achievement of the objective *** can hardly be said to be within the scope of the claims.

Id. At 431.

Counsel further notes that the §112, first paragraph rejection is untenable in view of the disclosure as filed and is contrary to MPEP §2164.08(c) reproduced, in part, below:

Limiting an applicant to the preferred materials in the absence of limiting prior art would not serve the constitutional purpose of promoting the progress in the useful arts. Therefore, an enablement rejection based on the grounds that a disclosed critical limitation is missing from a claim should be made only when the language of the specification makes it clear that the limitation is critical for the invention to function as intended. Broad language in the disclosure, including the abstract, omitting an allegedly critical feature, tends to rebut the argument of criticality.

Accordingly, the §112, first paragraph rejection should be withdrawn.

The §112, second paragraph objection to the terminology "elevated temperature and pressure" should also be withdrawn, especially in view of the teachings in the specification as to what these terms mean. Elevated pressure and temperature are discussed in the specification at pages 15, for example, where temperatures from 230°F to 370°F are recited and saturated steam pressures of from 5-150 psig are noted. *So also*, elevated temperatures and pressures are specified in the various examples; note Table 1 and following, beginning on page 28. Based on the disclosure, there is little doubt "elevated temperature and pressure" has its ordinary meaning; that is, temperature and pressure above ambient conditions. The other claim recitation in the pending claims, including the processing steps, leave little doubt as to claim scope.

Even terms of degree, which are less precise than relative terms such as "elevated" do not, *per se*, render a claim invalid. MPEP §2173.05(b). If the specification or prior art provides sufficient guidance as to claim scope, terms of degree ("about", "substantially" and so forth) are entirely permissible. Likewise, neither the Office nor the courts have required temperature ranges or other specifics as to processing steps. Only reasonable particularity and distinctness are required.

MPEP §2173.02.

Illustrative is the *Mayhew* case cited by the Examiner in the last Office Action. In that case, certain claims were rejected because the applicant had not specified a temperature range for cooling nor a location of the cooling bath. The Court reversed the rejection and allowed the claims noting:

Appellant argues that the recitation of a specific temperature *range* would be unduly restrictive. The board and solicitor seem to agree on this point inasmuch as they merely insist that the *function* of the cooling zone be recited. However, we find that the cooling zone is taught to accomplish various functions, some of which are dependent upon numerous variables. Reading the claims, as they must be read, in the light of the specification, we think that the general function of the cooling zone is clear from the other recitations of the claims and that selection of the temperature of the zone would be within the ability of one of ordinary skill in the art attempting to follow the teaching of the specification. It is also apparent that the temperature of the cooling zone would have to be regulated to meet varying conditions, such as the temperature of the main body of the

bath, the thickness of the strip, the speed of its movement through the bath, etc.....

The Federal Circuit has also consistently confirmed that only a reasonable degree of precision is required in claims. *Note In re Marosi*, 218 USPQ 289, where the Court reversed a §112, second paragraph rejection in view of the examples in the specification:

Insofar as it requires appellants to specify a particular *number* as the cutoff between their invention and the prior art, the PTO's position is impractical. Appellants' invention does not reside in such a number. The PTO's challenge is reminiscent of the argument advanced by the board in *In re Mattison*, 509 F.2d 563, 184 USPQ 484 (CCPA 1975). In that case, the board held that a compound claim requiring an electron withdrawing substituent selected and positioned on the aromatic ring "to substantially increase the efficiency of the compound as a copper extractant" failed to satisfy the second paragraph of 35 U.S.C. §112. The board said: "How much is a substantial increase? Is it 3%, 30%, 300%, or something else?" *Id.* at 564, 184 USPQ at 485. Reading the claims in light of the specification, the Court of Customs and Patent Appeals reversed, saying: General guidelines are disclosed [in the specification] for a proper choice of the substituent Ep together with a representative number of examples. If the prior art [compound] is modified by the inclusion of *** substituent Ep as claimed, resulting in substantially increased efficiency ***, the compound is within the scope of the claims. Hypothesizing whether an increase in efficiency of 3%, 30%, or 300% is necessary for said increase to be classified as substantial is not determinative of the issue of whether the claims satisfy 35 U.S.C. §112, second paragraph. *Id.* at 565, 184 USPQ at 486. (Footnote omitted.)

Id. at 292.

In this application, the terminology "elevated temperature and pressure" clearly requires temperatures and pressures above ambient conditions. Moreover, the processing steps in the claims and the examples in the specification leave little doubt as to claims scope. §112, second paragraph does not require more.

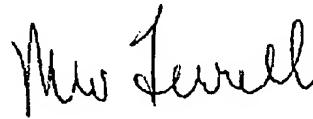
In view of the above amendments and remarks, this case is believed in condition for allowance. Such action is earnestly solicited. If for any reason the Examiner believes a telephone conference will in any way expedite prosecution of this case the Examiner is invited to call at the number listed below.

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This response is believed timely. If an extension becomes necessary, please consider this paper a *Petition* therefor and charge our Deposit Account No 50-0935.

This *Amendment* submits additional claims. If fees are due for additional claims, please charge our Deposit Account No. 50-0935.

Respectfully submitted,



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